

## **REMARKS**

### **Status of the Claims**

Claims 1, 2, 5-9, 11, 14 and 15 are pending.

Claims 3-4, 10, 12-13 and 16-20 have been cancelled.

Claims 1-11 and 14-15 (all in part) are deemed allowable, as indicated in the decision by the Board of Patent Appeals and Interferences ("BOPAI") on April 26, 2004, but objected to as containing non-elected subject matter.

### **Amendments**

Claim 1 was amended to conform with the restriction requirement to teach the subject matter of Group I and Species A and to include the limitation from claim 10. As such, claim 10 was cancelled from the case.

Claim 5 was amended to incorporate the amendments referenced in Applicants' Appeal Brief dated March 14, 2002. Specifically, claim 5 was amended to replace the incorrect dependency to cancelled claim 3 with the correct dependency to independent claim 1; replace the phrase "an additional" with the word -- a --; and insert the sequence identifier -- (SEQ ID NO: 1) -- from cancelled claim 3.

Claim 6 was amended to match the antecedent basis for the word "substituent" from amended claim 5.

Claims 11 and 14 were amended to replace the incorrect dependencies to cancelled claim 10 with the correct dependencies to independent claim 1.

Claim 14 was also amended to comply with the restriction requirement so that the claim teaches only the subject matter taught in Species A-- i.e., "an oxazole or an analogous ring." In this regard, Applicants kindly note that the thiazole structures have been kept as "analogous rings" to oxazole in limitations (I) and (IV) in claim 14.

Claim 15 was amended to comply with the restriction requirement in that the claim now teaches only the subject matter taught in Species A.

Applicants believe that the present amendments do not introduce new matter and do not broaden the scope of the claims.

**Objections**

The objection of claims 1-11 and 14-15 as being drawn to non-elected inventions should now be overcome by the present amendments to the referenced claims. Thus, Applicants kindly request issuance of the instant application at an early date.

**Office Communication of December 22, 2003**

In the above-referenced Office Communication (Paper No. 28), Supervisory Patent Examiner Sreeni Padmanabhan kindly notified Applicants that the Second, Third and Fourth Supplemental IDS submissions dated September 30, 2002 (Paper No. 24), October 31, 2002 (Paper No. 25) and May 19, 2003 (Paper No. 27), respectively, fail to comply with 37 CFR §§ 1.97 and 1.98 and MPEP § 609 because they were filed after the mailing date of the Examiner's Answer (Paper No. 21) on June 17, 2002. The Examiner further noted that the IDS submissions were placed in the application file, but that the information referred to therein has not been considered as to the merits. Applicants respectfully disagree with this determination and request that the Second, Third and Fourth Supplemental IDS submissions be considered on the merits because, as detailed below, they were originally submitted in compliance with 37 CFR § 1.97, 1.98 and MPEP § 609.

In an interview with Examiner Padmanabhan on or about September 14, 2004, the undersigned Applicants' Attorney, Joseph C. Wang, requested clarification of this Office Communication. Examiner Padmanabhan suggested that Mr. Wang contact Technical Specialist Anthony Capputa for further clarification. On September 15, 2004, Mr. Wang discussed this issue with Mr. Capputa, who kindly informed Mr. Wang that he would respond to Mr. Wang after researching the issue and discussing it with his colleagues. On September 17, 2004, Examiner Padmanabhan informed Mr. Wang that he discussed this issue with Mr. Capputa, and they suggested that Applicants include in their response to the Office Action of July 21, 2004, a request that the Examiner consider the Second, Third and Fourth Supplemental IDS submissions and an account of the history of the Supplemental IDS submissions along with supporting documentation.

In furtherance of the above-referenced discussions with Examiner Padmanabhan and Mr. Capputa, Applicants attach herewith copies of the originally-filed Second, Third and Fourth Supplemental IDS submissions. As is evident, each Supplemental IDS was filed in compliance with 37 CFR § 1.97(d) in that each one was filed after the period specified in 37 CFR § 1.97(c) but before the payment of the issue fee. Additionally, each Supplemental IDS was accompanied by the

statement specified in 37 CFR § 1.97(e) and the fee set forth in 37 CFR § 1.17(p). Each Supplemental IDS meets the requirements of 37 CFR § 1.97(e)(1) in that the references cited therein were all "first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement." Hence, each of the Second, Third and Fourth Supplemental IDS submissions satisfied the statutory requirements in their original filings and still satisfy those requirements. For the reasons stated above, Applicants respectfully request that the references cited in the Second, Third and Fourth Supplemental IDS submissions be considered on the merits.

**FEES**


No fees should be due. However, if it is determined that a fee is due, please charge same to Deposit Account No. 19-3880 in the name of Bristol-Myers Squibb Company.

**SUMMARY**

In view of the foregoing, it is requested that this case proceed to issuance. The Examiner is invited to contact the undersigned if it is believed prosecution could be expedited.

Respectfully submitted,

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